

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

**Status of Claims:**

No claims are currently being added or canceled.

Claims 1, 7, 8, 17, 20 and 23 are currently being amended.

This amendment and reply amends claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-5, 7, 8, 13, 15, 17, 18, 20, 21, 23, 24 and 26-32 remain pending in this application.

**Claim Rejections – Prior Art:**

In the Office Action, claims 1-4, 7, 8, 14, 16, 17, 20, 22, 23, 28 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,377,804 to Lintulampi in view of U.S. Patent No. 6,014,565 to Bonta; claims 5 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of Bonta and further in view of U.S. Patent No. 6,556,820 to Le et al.; claims 13, 15, 18, 19, 21, 24 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of Bonta and further in view of U.S. Patent Publication No. 2001/0046863 to Rinne; claims 27 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of Bonta and further in view of U.S. Patent No. 6,216,004 to Tiedmann, Jr. et al.; and claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of Bonta and further in view of U.S. Patent N. 7,200,110 to Burns. These rejections are traversed with respect to the presently pending claims under rejection, for at least the reasons given below.

The invention according to claim 1 is directed to a method of establishing UMTS communication between a User Equipment (UE) and a Universal Mobile Telecommunications System (UMTS) network, in which UTRAN parameters are forwarded to the UE via a GSM-type network, and in which the UTRAN parameters comprise a list of at least one access node. The claimed UTRAN parameters that comprise a list of at least one

access node, which are forwarded to the UE via the GSM-type network, are not disclosed, taught or suggested by Lintulampi.

The Office Action recognizes this deficiency in Lintulampi, and relies on Bonta for providing the missing teachings in Lintulampi. In particular, the Office Action asserts that step 408 in Figure 4 of Bonta teaches a list of at least one potential node. Figure 4 of Bonta is a flow chart representing a method for service planning in a radiotelephone system, whereby step 408 states that a handover neighbor list for a mobile communication unit is generated using a variety of algorithms, based on corresponding signal quality metrics. As described in column 8, lines 18-32 of Bonta, a route of travel for a mobile communication unit relative to a source BTS is determined, and from that route of travel a handover neighbor list based on corresponding signal quality metrics is generated. However, this is not especially relevant to the features recited in independent claim 1, in which a user equipment (UE) is in communication with a GSM-type network, and whereby a list of at least one access node is utilized to switch communications with the UE to a UMTS network. Rather, in Bonta, the mobile communication unit remains on the same CDMA network during a handover that utilizes the handover neighbor list, and no switch to another communication network is performed in the system of Bonta. Accordingly, since it would not make sense to combine Bonta with Lintulampi in the manner suggested on page 3 of the Office Action, and at the very least the handover neighbor list of Bonta would not be used to switch communications with the UE from the GSM-type network to the UMTS network, since Bonta is a single-network system, independent claim 1 is patentable over the cited art of record.

Presently pending independent claims 7, 8, 17, 20 and 23 recite similar features to those discussed above with respect to independent claim 1, and thus those independent claims are also patentable over the cited art of record.

The dependent claims under rejection are patentable over the cited art of record for the specific features recited in those claims, as well as due to their respective dependencies on one of the presently pending independent claims, the patentability of which is discussed above.

For example, with respect to the rejection of dependent claims 5, 27, 30 and 31 the Office Action asserted that Tiedmann, Jr. et al. and Le et al. taught certain features recited in claims 5, 27, 30 and 31. Applicants respectfully disagree.

Dependent claim 5 recites potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links. Le discloses a MS which provides a list of USIM-IDs and how to manage the multiple USIM-IDs (for example, see column 11, lines 6-8 and 15-18 of Le). In column 2, lines 43-58 of Le, it discloses that USIM-IDs are used for managing multiple subscriptions. Thus, the list of USIM-IDs is a list of subscriptions of a MS, and there is no disclosure or suggestion that the UTRAN parameters comprise a list of at least one access node.

Still further, in Le et al., a MS provides a list of USIM-IDs during a Location Area Update (LAU) using a single message in the form of a LAU REQ signal that includes each of the application USIM-IDs. See column 11, lines 15-18 of Le et al. Column 13, lines 2-10 of Le et al. discloses that USIMs can be individually activated/deactivated on a dynamic basis, in which a USIM-ID Add or USIM-ID Delete message is used to signal the addition or deletion of one or more USIM-IDs. This description in Le et al. says nothing about deleting potential links supplied in a list of available links to the UE on which satisfactory communication is not possible, since the adding and deleting of USIM-IDs as described in Le et al. appears to be done on an MS-selected basis with no detailed description as to the criteria used by the MS in performing that selection.

The Office Action points to column 13, lines 2-10 of Le et al. for allegedly teaching that potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links, but Applicants respectfully disagree. Namely, column 13, lines 2-10 of Le et al. describes that the Mobile Station (MS) can use a USIM-ID Add or USIM-ID Delete message to signal the addition or deletion of one or more USIM-IDs, whereby a USIM corresponds to a UMTS Subscriber Identity Module. There is nothing concerning the determination of whether satisfactory communication is made and whether or not such a determination is used as a criteria for deleting potential links on a list in this portion of Le et al.

Accordingly, since Lintulampi and Bonta do not rectify the above-mentioned deficiencies of Le et al., dependent claim 5 is patentable over the combination of Lintulampi, Bonta and Le et al.

Dependent claims 27 and 31 recite switching directly from a mode in which the UE is in communication with a GSM base station to a UMTS diversity mode in which the UE is in

communication with a plurality of UMTS access nodes. In its rejection of claims 27 and 31, the Office Action cites column 14, lines 50-65 of Tiedemann, Jr. et al. for allegedly teachings the features recited in these claims. Applicants respectfully disagree. Namely, column 14, lines 50-65 of Tiedemann, Jr. et al. describes that if the mobile unit is in a handoff mode communicating to multiple base stations or in a cell diversity mode, the calls are routed to the appropriate base stations for transmission to the appropriate base station transmitter to the intended recipient mobile station. However, this use of diversity communications is for a single network, and thus, at best, Tiedemann, Jr. et al. describes switching from a non-diversity mode to a diversity mode for a single network, and it does not teach or suggest switching from a non-diversity mode in a first network to a diversity mode in a second network different from the first network.

Since none of the other cited art of record rectifies these deficiencies of Tiedemann, Jr. et al., dependent claims 27 and 31 are patentable over the cited art of record.

Dependent claim 30 recites that the UTRAN parameter information output from the UMTS network tunnels through the GSM-type network without being interpreted or processed in any manner by the GSM-type network. As seen in Figures 4a, 4b, 5a and 5b of Lintulampi, on the other hand, the GSM components do appear to interpret and/or process signals sent between the MS and the UMTS network. See, for example, steps 3, 4 and 5 in Figures 4a and 4b of Lintulampi. The Office Action recognizes this deficiency of Lintulampi, and points to Figure 8, element 810 of Le et al. for allegedly teaching this feature. However, element 810 in Figure 8 of Le et al. merely is an Iu interface between a 3G MSC/VLR and an RNC, whereby there is no teaching or suggestion that the 3G MSC/VLR and the 3G SGSN components of the GSM network do not process UTRAN parameter information that may or may not pass through the Iu interface 810.

Accordingly, dependent claim 30 is patentable over the cited art of record.

**Conclusion:**

Since all of the issues raised in the Office Action have been addressed in this Amendment and Reply, Applicants believe that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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